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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/720,648      | 11/24/2003  | Donald H. Martin     |                     | 4683             |

7590                      01/05/2006  
Donald H. Martin  
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Asheville, NC 28804

EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT                      PAPER NUMBER

1711

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

4

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/720,648 | <b>Applicant(s)</b><br>MARTIN, DONALD H. |  |
|                              | <b>Examiner</b><br>Ana L. Woodward   | <b>Art Unit</b><br>1711                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on December 12, 2005
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 3-19 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1, 2, 20 and 21 is/are rejected.
- 7)  Claim(s) 21 is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a)  All    b)  Some \*    c)  None of:
1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Finality of Last Office Action Withdrawn*

1. The finality of the last office action mailed October 24, 2005 has been withdrawn.

### *Response to Amendment*

2. Applicant's amendment filed December 12, 2005 has been entered. The numbering of claims, however, is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. **When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).**

Misnumbered new claim 2 (dependent to amended claim 1) and new claim 3 (dependent to claim 2) have been renumbered as claims 20 and 21, respectively. Applicant is requested to preserve this numbering throughout the prosecution.

### *Election/Restriction*

3. The election of species requirement mandated February 28, 2005 has been withdrawn.
4. Claims 3-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 26, 2005.

### *Claim Rejections - 35 USC § 112*

5. Claims 1, 2, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 1, line 1, the term “general” is objected to.

In claim 1, regarding the value of n, it is unclear how zero can be definitive of a “positive integer”.

In claim 2, it is not apparent what is meant by “hindered”.

***Claim Rejections - 35 USC § 102/103***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 3829455 A1 (see english abstract).

The reference is directed to the preparation of benzenesulfonamidoalkylcyclohexane compounds and their use as pharmaceuticals. As per the english translation thereof, cyclohexanepropanoic acid, 4-(2-aminoethyl) is used in the preparation thereof.

Cyclohexanepropanoic acid, 4-(2-aminoethyl) meets the presently claimed cyclohexyl based rigid ring amino acid because it has an effective methylene group of 8, which is greater than 5 and less than 27, and a carbon number of 11, which is greater than 9 and less than 34.

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It is reasonable to presume that the  $--(\text{CH}_2)_2\text{-CO}_2\text{H}$  linkages meet the "hindered" limitation of the present claim.

9. Claim 2 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese 49041355 B4 abstract.

The reference discloses an amino acid based on cyclohexane having a methylene length of 10, which is greater than 4 and less than 27, and a carbon number of 10, which is greater than 9 and less than 34.

It is reasonable to presume that the  $--(\text{CH}_2)_3\text{-CO}_2\text{H}$  linkage meets the "hindered" limitation of the present claim.

***Claim Rejections - 35 USC § 103***

10. Claims 1 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese 49041355 B4 abstract, described hereinabove.

The reference discloses an amino acid based on cyclohexane having a methylene length of 10, which is greater than 5 and less than 27, and a carbon number of 10.

In essence, the reference differs from the above-rejected claims only in that the carbon number is 10, as opposed to greater than 10. Homologues are a class of compounds differing only by a methylene linkage and possessing similar structures. Accordingly, it would have been obvious to one having ordinary skill in the art to have replaced the  $--(\text{CH}_2)_3\text{-}$  portion in the amino acid formula of the reference with a homologous  $--(\text{CH}_2)_4\text{-}$  portion in view of their closely related structures and the resulting expectation of similar properties. Accordingly, absent evidence of unusual or unexpected result for the homologous amino acid containing the  $--(\text{CH}_2)_4\text{-}$  portion, no patentability can be seen in the presently claimed subject matter.

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*Allowable Subject Matter*

11. Claim 21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

*Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

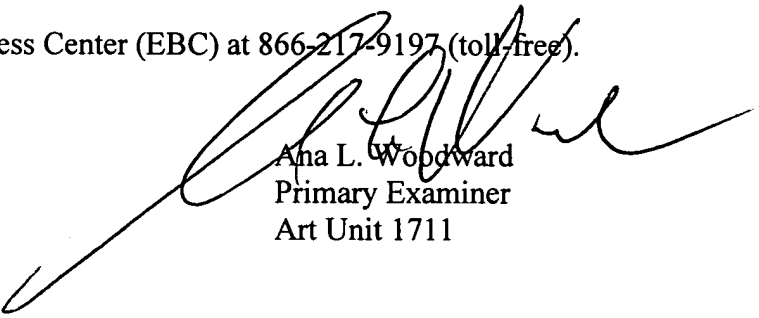
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ana L. Woodward  
Primary Examiner  
Art Unit 1711

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